

RESPONSE under 37 C.F.R. § 1.116  
U.S. Appln. No. 10/762,674

**REMARKS:**

By this amendment Applicant cancels claims 2 and 3 and adds new claims 21 and 22 thus claims 1, 4-19 and 21-22 are all the claims pending in the present application and stand rejected. Reconsideration and allowance of all pending claims are respectfully requested in view of the remarks that follow.

**PREMATURE FINAL ACTION.**

The Office Action indicates that it was made final because "Applicant's amendment necessitated the new ground(s) of rejection presented." (9/15/05 Final Office Action; pg. 3). Applicant respectfully disagrees. In the previous response filed on July 5, 2005, Applicant's amendments clarified limitations already present in existing claims for consistency and did not present any single new limitation by way of amendment. For example, Applicant amended claim 1 to recite *a portable housing unit* and a *locking retaining portion clip*. These limitations were already recited either in the same claim or a dependent claim (e.g., claim 1 and claim 3) and thus no new limitations were included. In regard to independent claim 11, no amendments were presented whatsoever. Lastly, independent claim 18 was amended to recite *a carabiner clip* which was already present in dependent, now cancelled, claim 20. Accordingly, Applicant did not present any issues by way of amendment which necessitated a new search or ground of rejection. 37 C.F.R. § 1.116(b)

The Office Action now cites two entirely new prior art references (admittedly forming new grounds of rejection) against Applicant's claims. The new references could have been cited against the claims as originally filed but, through no fault of Applicant, were not. MPEP 706.07(a). Reconsideration and withdrawal of the finality of the instant Office Action is therefore requested. If, after reconsideration, the finality of the Office Action is determined to have been premature, the Examiner is respectfully requested to enter the foregoing amendments in accordance with 37 C.F.R. § 1.111. If however, the finality of this Office Action is not

RESPONSE under 37 C.F.R. § 1.116  
U.S. Appln. No. 10/762,674

specificity, how amending claims to recite limitations already existing in the pending claims allegedly "necessitates" a new ground of rejection.

**CLAIM REJECTIONS.**

**35 U.S.C. § 103**

1.) Claims 1-2, 5-16 and 18-19 stand rejected under 35 U.S.C. § 103 as being unpatentable over newly cited U.S. Patent 6,934,568 to Charlier et al. (hereinafter "Charlier") in view of U.S. Published Patent Application US2005/00115042 to Willkens. Applicant respectfully traverses these rejections for the following reasons.

It is well established that a *prima facie* obviousness is only established when three basic criteria are met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991) (MPEP 2144).

In the instant rejection, the Office Action relies on Charlier to disclose all of Applicant's recited limitations with the exception of Applicant's claimed *locking retaining clip*<sup>1</sup>. The Office Action relies on Willkens to make up for this notable deficiency.

Generally, Charlier discloses a communication device (Fig. 4) which has a base housing 16, a flip housing 12 and an extendable housing 14. A separate latch and release mechanism 49 can be provided for holding or releasing the extendable housing 14 and can include small tabs and other protrusions for engaging with corresponding receiving tabs on the base housing 16.

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<sup>1</sup> The rejection alleges that Charlier discloses "a locking retaining portion" as element 49 but then alleges it fails to "disclose a locking retaining clip."

RESPONSE under 37 C.F.R. § 1.116  
U.S. Appln. No. 10/762,674

(Col. 5, ll. 42-47). The separate sides of the extendable housing 14 can be squeezed together to provide clearance for the tabs of latch mechanism 49 to release extendable housing 14 (which may be spring loaded).

Applicant respectfully submits the Office Action incorrectly alleges Charlier's base housing 16 is "a memory" and/or its electrical input/output connector 44 is "a data interface port." While it is possible base housing 16 could include a memory or connector 44 could be a data interface port, Charlier does not, expressly or implicitly, disclose either of these elements, thus *prima facie* obviousness has not been established for this reason alone. For example, there is no teaching or suggestion by Charlier that connector 44 is anything but provide an interface for electricity (e.g., for use with an automobile power adapter; col. 5, ll. 42). Furthermore, there certainly is no mention of connector 44 being "communicatively coupled to a memory" as expressly recited in Applicant's claim 1 and 18.

However, Applicant submits the most notable deficiency of Charlier is in respect to a portable housing including a *locking retaining clip* (claim 1) or a locking retaining portion (claim 11). Instead, the Office Action relies on Willkens to teach this feature.

Willkens discloses a magnetic retaining or holstering device for attaching a hand-held scanner to the body (Title). The Willkens device includes a magnetic snap cap 10 which includes a connector tip 12 for inserting into the end of a receptacle 30 (par. [0016]; Fig. 3c). A magnet 14 is at least partially embedded in the front face 16 of cap 10 to contact with a magnetic surface 34 of the end of the receptacle 30. The receptacle 30 holds the wireless device (i.e., portable scanner) and a clip 50 can be used to attach to cap 10 to an article. In other words, the receptacle 30 can be removed from a clipped surface merely by pulling (i.e., separating the magnet in cap 30 from magnetic surface 35 of the receptacle. Willkens does not disclose a locking retaining portion which is part of a housing.

RESPONSE under 37 C.F.R. § 1.116  
U.S. Appln. No. 10/762,674

Without admitting the motivation for combining reference is even proper, Applicant respectfully submits that even when combining Charlier and Willkens, the resulting combination fails to teach or suggests all of the limitations claimed by Applicant. For example, Applicant's independent claims recite a *housing (unit) including a locking retaining portion (or clip)*. This feature is not disclosed even by the combination of cited references as the "housing" 16 of Chartier certainly would not include a locking retaining portion (having the features recited in Applicant's claims), even if the Willkens receptacle were adapted to somehow hold the Chartier device. Additionally, Chartier housings 12, 14 and 16 do not appear to include a magnetic surface for which Willkens cap 10 could magnetically adhere to. Notwithstanding, by the amendments above, Applicant has clarified the independent claims to recite that at least a portion of the housing unit is formed as a locking retaining portion (clip). Chartier and Willkens, taken alone or in combination, fail to teach or suggestion this feature and thus Applicant's independent claims are believed to clearly be patentable over the cited combination.

Lastly, while briefly mentioned in the Office Action, without any supporting citations, Applicant respectfully believes many additional features in the claims (even prior to this amendment) are not disclosed or suggested. By way of example, Applicant provides the following list of features not disclosed or suggested by either reference.

Claim 2- *locking retaining clip is integral with the portable housing unit;*

Claims 5,12,13- *the portable electronic device comprises a digital camera (or digital video device);*

Claims 6,7,14,15 - *the portable electronic device comprises an audio device (or MP3 player);*

Claims 8,16- *the memory comprises a flash memory OR the data interface port comprises a USB interface; and*

RESPONSE under 37 C.F.R. § 1.116  
U.S. Appln. No. 10/762,674

Claim 10- *the locking retaining clip is configured as a protective cover for the data interface port*

Since Chartier and Willkens, taken alone or in any combination, fail to teach or suggest any of the foregoing limitations, *prima facie* obviousness is not established. In view of the foregoing, Applicant respectfully requests reconsideration and withdrawal of the §103 rejection based on the combination of Chartier and Willkens.

2.) Claims 3-4, 17 and 20 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Chartier in view of Willkens and in further view of U.S. Appln. US 2001/0027151 to Siaperas. Applicant respectfully traverses this rejection for the following reasons.

The Office Action relies on Chartier and Willkens to disclose all the subject matter of these claims with the exception that the clip comprises a carabineer clip and/or pivotally connected to the portable housing and relies on Siaperas to make up for this deficiency.

Applicant respectfully disagrees but points out that Willkens does appear to disclose a "carabineer" clip (pg. 2, par. [0018]) and, from Fig. 3a, it may actually have a pivotal connection. Therefore, the citation of Siaperas appears to be extraneous and, even if it is not, it is not considered pertinent by virtue of it being non-analogous art (i.e., exercise equipment) for the reasons discussed in Applicant's previous response. Notwithstanding that Applicant previously cancelled claim 20 and cancels claim 3 above, Applicant respectfully submits that Siaperas (or Wang) or any prior art of record fails to make up for the deficiencies of the Chartier and Willkens combination previously discussed. Accordingly, for at least the reasons, Applicant respectfully requests the Examiner to reconsider and withdraw this §103 rejection.

#### **NEW CLAIMS.**

By this amendment, Applicant adds new claims 21 and 22 and respectfully requests examination and favorable consideration thereof. New claims 21 and 22 are similar to claims 9

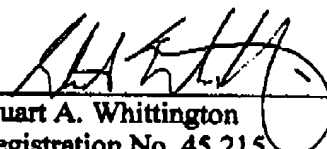
RESPONSE under 37 C.F.R. § 1.116  
U.S. Appln. No. 10/762,674

and 10 and are believed to be patentable for at least the same reasons. No new matter is believed to be included in the new claims.

**CONCLUSION.**

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

Respectfully submitted,

  
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